

**REMARKS**

For the sake of clarity, claim 13 has been amended to correct an obvious typographical error. As now amended, claim 13 depends from claim 12 instead of claim 10. Claim 13 recites a preferred method wherein the step of applying an adhesive comprises an ambient atmosphere soak process. It is respectfully submitted that dependence from base method claim 12 was clearly intended. Applicants infer that the foregoing amendment of claim 13 would not alter the allocation of claims among the inventions, as defined by Groups I, II and III of the restriction requirement, which is addressed hereinafter, and the provisional election responsive thereto. The substantive features recited in amended claim 13 have not been changed by the amendment thereto, and each of claims 10, 12, and 13 has been classified in the Group II.

The Examiner has required restriction under 35 USC 121 to one of the following inventions:

- I. Claims 11, 31, and 54, drawn to a magnetic metal component, classified in class 428, subclass 826;
- II. Claims 1-10 and 12-19, drawn to a process of adhesively bonding a magnetic metal, classified in class 156, subclass 184; and
- III. Claims 20-30, 32-53, and 55-59, drawn to a process of making a magnetic metal, classified in class 29, subclass 603.1.

The Examiner has stated that the inventions, as grouped, are separate and distinct.

In response to the restriction requirement, applicants hereby elect, with traverse, the invention of Group III, i.e. claims 20-30, 32-53, and 55-59, for further prosecution on the merits.

Reconsideration of this restriction requirement is respectfully requested.

Applicants respectfully submit that the relationship between: (i) the magnetic metal component of Group I (claims 11, 31, and 54); (ii) the process of adhesively bonding a magnetic metal of Group II (claims 1-10 and 12-19); and (iii) the process of making a magnetic metal component of Group III (claims 20-30, 32-53, and 55-59) is an interdependent one, there being both method and structural concepts in the broad aspect of the invention.

It is well established that applicants should be allowed reasonable latitude in claiming their invention, provided they do not unduly multiply the claims, which is not the case here. Ex parte Seiback 151 U.S.P.Q. 62. It is submitted that the fields of search involved in examining the claims as grouped would, as a practical matter, be essentially co-extensive and the best interests of the public would be served by having all of the claimed subject matter in the same application.

The Examiner has indicated that the inventions of Groups II and III and Group I are related as process of making and product made. With respect to Group I, which includes three product claims delineated in product-by-process form, the Examiner has alleged that the three-dimensional mass of claim 11 and the electro-mechanical components of claims 31 and 54 can be made by different processes, such as processes that utilize a self-sticking adhesive that does not need curing or thermal processing. Applicants respectfully submit that as a practical matter, virtually all adhesives require some form of curing or thermal processing, as those terms are used in the present specification, although such curing or thermal processing is possibly effected in a very short time period. It is therefore submitted that the field of search pertinent to the invention of Group I would, as a practical matter, be substantially coextensive with the field of search pertinent to Groups II and III.

Accordingly, reconsideration of the restriction requirement between Group I and Groups II and III is respectfully requested.

The Examiner has further contended that Group II (claims 1-10 and 12-19) and Group III (claims 20-30, 32-53, and 55-59) are related as subcombinations disclosed as usable together in a single combination. According to MPEP 806.05(d), on which the Examiner has apparently relied, it is said that “Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.” In the present instance, applicants acknowledge that the subcombinations are disclosed as being usable together in a single combination or separately usable. However, the predicate of MPEP 806.05(d) for restriction also requires the showing that the subcombinations both do not overlap in scope and are not obvious variants. It is respectfully submitted that the Examiner has not made the requisite showing. The independent claims of Group II both call for winding soft magnetic metal ribbon, into either a three dimensional shape (claim 1) or a toroid (claim 12), which is clearly one form of three dimensional shape. Claim 12 further requires applying an adhesive and curing the adhesive. On the other hand, the method used to make a soft magnetic metal component delineated by claim 20 (Group III) includes the steps of winding soft magnetic metal ribbon into a toroid and containing the toroid within a toroidal geometry. As delineated by claim 21 (dependent on claim 20), one form of the containing step comprises applying an adhesive to the toroid and curing the adhesive. It is thus submitted that there is clear overlap in scope between at least claims 12 and 20, so that the distinctions between the alleged Groups I and II required to predicate a proper restriction between Groups II and III has not been established. It is further submitted that the interests of the public would best be served by the joint examination of the claims of Groups II and III, respectively directed to processes for adhesively bonding a magnetic metal to form a magnetic metal mass and for manufacturing a soft magnetic metal electro-mechanical component.

Accordingly, reconsideration of the restriction requirement with respect to Groups II and III is respectfully requested.

The Examiner has required further restriction if either Group II or Group III is elected.

As set forth above, applicants have elected, with traverse, Group III for further prosecution on the merits. The Examiner has indicated that if Group III is elected, a further restriction is required under 35 USC 121 to one of the following inventions within Group III:

- III-A. Claims 22 and 24-28, drawn to a process that includes applying an adhesive with an atmospheric soak process, classified in class 156, subclass 314;
- III-B. Claims 23-28, drawn to a process that includes providing a vessel containing the adhesive, classified in class 156, subclass 285;
- III-C. Claim 33, drawn to a process that includes removing a toroid from a milling assembly, classified in class 29, subclass 426.2;
- III-D. Claims 35-53 and 55-59, drawn to a process that includes placing an inner ring, an outer ring, and a hat, classified in class 29, subclass 609; and
- III-E. Claims 35-53 and 55-59, drawn to a process that specifically mills with a cutting tool, classified in class 409, subclass 66.

In response to the further restriction requirement, applicants provisionally elect, with traverse, the claims of Group III-D (i.e., claims 35-53 and 55-59) for further prosecution on the merits.

The Examiner has acknowledged that the inventions of Groups III-A through III-E are directed to related inventions of magnetic metal. He has relied on the provision of MPEP 806.05(j), which permits restriction among claims to related products, subject to three requirements that all must be satisfied. In particular, the inventions as claimed must be: non-overlapping, mutually exclusive in

scope; not obvious variants of each other; and either not capable of use together or materially different in design, mode of operation, function, or effect.

It is respectfully submitted that these three criteria have not all been satisfied with respect to the inventions of Groups III-A through III-E. Even if, *arguendo*, the Examiner is correct in the contention that the inventions as grouped have a materially different manufacturing function and effect, he has not established that the inventions are all non-overlapping and mutually exclusive in scope, nor that they are not obvious variants.

Significantly, certain of the claims within overall Group III have been placed in multiple ones of the sub-groups. For example, claim 24, which is multiply dependent on claims 22 and 23, and claims 25-28 (dependent from claim 24) are designated in both Groups III-A and III-B; claims 48-49 have been designated in both Groups III-D and III-E. These overlapping designations clearly preclude a finding that Groups III-A and III-B or Groups III-D and III-E are non-overlapping and mutually exclusive in scope.

With respect to claims 22 and 23, respectively designated in both Groups III-A and III-B, applicants point out that these claims call for processes in which the step of applying adhesive comprises an atmospheric soak process (claim 22) and immersing the toroid in a vessel of adhesive that is evacuated (claim 23). Neither claim includes language that precludes a process in which a toroid is sequentially soaked in a vessel of adhesive under atmospheric pressure and then evacuated. Claims 25-29, which depend from claim 24, also do not contain language which precludes a process including both an atmospheric soak and an evacuation, as respectively recited by claims 22 and 23, from which claim 24 is multiply dependent. Accordingly, it is submitted that the claims of Groups III-A and III-B are not properly regarded as being mutually exclusive or non-overlapping in scope, precluding the propriety of restriction between Groups III-A and III-B.

Applicants further maintain that restriction between Groups III-D and III-E is not proper. While an inner ring, outer ring, and hat are not recited by claims 48-49 of Group III-E, nothing therein precludes the use of such fixturing during the required milling step recited in these claims. A milling step is inherited by claims 48-49 from base claim 32, from which they depend. Claims 48-49 merely recite a particular form of the milling step, which may be carried out in conjunction with use of the inner ring, outer ring, and hat said to be the distinguishing features of Group III-D, which features are variously recited by claims 35-47, 50-53, and 55-59. Accordingly, it is submitted that the claims of Groups III-D and III-E are not mutually exclusive and non-overlapping in scope, as would be required for a proper restriction requirement between these claims as grouped.

Each of the claims dependent from base claim 32 requires containment of the toroid in a milling assembly. While Group III-C (claim 33) requires removing the toroid from that milling assembly, nothing in the claims of Groups III-A, III-B, III-D, or III-E precludes a removal. Accordingly, Group III-C is submitted not to be mutually exclusive of, and distinct from, any of the remaining subgroups of Group III.

Appreciation is expressed for the Examiner's indication that claims 20, 21, 32, and 34 link the inventions of Groups III-A through Group III-E. Applicants concur with this analysis, and request withdrawal of the restriction between Groups III-A through III-E upon allowance of one or more of the linking claims, which applicants respectfully submit are presently in allowable condition.

The Examiner has further required that if Group II be elected, then election must also be made

among allegedly patentably distinct species, viz.

| <u>SPECIES</u> | <u>CLAIM(S)</u>     |
|----------------|---------------------|
| A              | 2, 6-10, 13, and 15 |
| B              | 3                   |
| C              | 4                   |
| D              | 5-10 and 13-15.     |

The Examiner has required applicant under 35 USC 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner has acknowledged that claims 1, 12, and 16-19 are generic to the species A-D set forth above, and that upon allowance of one or more of said generic claims, applicants will be entitled to consideration of claims to additional species. In the present instance, claims 2-10 are all directly or indirectly dependent from claim 1, and claims 13-15 all depend directly from claim 12. It is submitted that applicants are reasonably entitled to consideration of all the Species A-D upon allowance of one or more of the pertinent generic claims.

Applicants also infer that the amendment of claim 13 to depend from claim 12 instead of claim 10 has no material bearing on the aforesaid allocation of the species of Group II, since claims 10 and 13 are classified together within Species A and D.

Inasmuch as applicants have provisionally elected Group III, and not Group II, it is submitted that no species election within Group II is now required.

In view of the foregoing remarks, applicants submit that the present application is not properly subject to restriction, as set forth in the August 1, 2006 Office Action. It is further submitted that the application, as now presented, is in condition for allowance. Accordingly, reconsideration of the

restriction requirement and allowance of the application, as delineated by claims 1-59, as amended, is respectfully requested.

Respectfully submitted,  
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A handwritten signature in black ink, appearing to read "Ernest D. Buff", written over a solid black horizontal line.

By  
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